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In re Application of:
ERIKSEN, ANDRE SLOTH
Serial No.: 10/578,578
Filed: May 5, 2006
Docket: ASE.001
Title: COOLING SYSTEM FOR A COMPUTER SYSTEM

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02 (VIII)

This is a decision on the petition filed on May 5, 2006 to make the above-identified application special under the accelerated examination procedure set forth in MPEP § 708.02(VIII) and in accordance with 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

In support of the petition, petitioner provides: 1) the applicable fee; 2) a statement that a search was made with the PCT application and submission of a copy of Nov. 4, 2004 PCT/DK 2004/000775 International Preliminary Report on patentability search report; 3) an IDS; and 4) a detailed discussion of the references.

For accelerated examination under MPEP § 708.02(VIII) in accordance with 37 C.F.R. § 1.102(d), a showing of the following is required: a) the applicable petition fee; b) all claims are directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, applicant will make an election without traverse; c) a statement that a pre-examination search was made, listing the field of search by class and subclass; d) a copy of each of the references deemed most closely related to the claimed subject matter; and e) a detailed discussion of the references pointing out with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is distinguishable over the references.

The requirements of MPEP § 708.02(VIII)(a) (c) and (d) are considered to have been met. However, the petition does not meet the requirements of MPEP § 708.02(VIII)(b) and (e).

Regarding the requirement of MPEP § 708.02(VIII)(b), it states that all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status. In the petition, this statement was omitted. It is noted that there were only one independent claim and eighteen dependent claims in the case. However, the examiner may determine there could be different species and embodiments involved in the case, which may result in election of species requirement.

Regarding the requirement of MPEP § 708.02(VIII)(e), 37 CFR § 1.111 (b) states "[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." 37 CFR § 1.111 (c) states in part "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made." The applicant failed to provide any discussion of twelve cited prior art references listed on Form 1449 nor did the applicant point out the particular language that distinguishes the independent claim 70, filed on May 5, 2006, from these references. The applicant's general allegations that the invention is patentable over the references run contrary to 37 CFR § 1.111 (b), which does not allow for general allegations. In the petition, the petitioner only described generally the cited references taken singularly or collectively fail to suggest or disclose a "cooling system" (per claim 70) having the claimed combination of features including a pump... comprising an impeller mechanically integrated with a pump rotor ... [and] submerged in the cooling liquid.... This is insufficient to comply with the requirements of MPEP §708.02 (VIII)(e). In particular, the petitioner failed to provide a comparison between the cited prior art documents with the independent claim 70. The independent claim must be compared with *each* of twelve cited references, and the patentable novelty in the independent claim 70 relative to *each* reference must be clearly pointed out. Because the petition does not point out the specific language in the independent claim 70 that distinguishes over each of twelve references, the petition fails to meet the requirements of MPEP §708.02 (VIII)(e). For example, the applicant failed to explain any specific limitations in claim 70 not shown or taught by the cited patent documents.

While Technology Center Directors may have granted petitions that do not comply with the detailed discussion requirement of the Accelerated Examination procedure, Technology Center Director decisions on petitions are not binding precedent of the Patent Examining Corps, and the application of an improper standard in certain cases does not require the Office to continue to apply the improper standard in all cases. *See* In re The Boulevard Entertainment, Inc., 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003).

For the above-mentioned reasons, the petition is dismissed. The application will, therefore, be taken up by the examiner for action in its regular turn.

Any request for reconsideration of this decision must be submitted within 2 (two) months of the date of this decision in order to be considered timely. Any request for reconsideration must provide (a) a statement that all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status; and

(b) a detailed discussion of each of twelve cited references that clearly points out the specific language in the independent claim that distinguishes over the references.

Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

Henry C. Yuen, Special Program Examiner
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